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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Akira Nonaka

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

KUCAB, JAMIE R

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

10/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/803,396	Applicant(s) NONAKA, AKIRA	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-18,31,33-35 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18, 31, 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicant's response filed June 8, 2010 is acknowledged.
2. Claims 1, 3-18, 31, 33-35, and 50 are pending in the application.
3. Claim 50 is withdrawn from consideration.
4. Claims 1, 3-18, 31, and 33-35 are examined below.
5. This Office action is given Paper No. 20101013 for reference purposes only.

Claim Rejections - 35 USC § 112, 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1, 3-18, 31, and 33-35 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Regarding claims 1 and 31, these claims invoke 35 U.S.C. § 112, sixth paragraph, however, the specification does not clearly link the "means" (or equivalent recitations) to corresponding structure. The recitations "an examiner for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus" (claim 1) and "an examiner for examining usage space information of the content data, the recording medium, and the reproducing apparatus" (claim 31) invoke 35 U.S.C. § 112, sixth

paragraph, because the recitation “examiner” is equivalent to a recitation of “means.”

The scope of the above two “an examiner for ...” recitations is then limited to the corresponding structures described in the specification. However, the specification does not clearly link corresponding structure to “an examiner.” Nor was such structure implicitly described in the specification in such a manner that it would have been understood by one of ordinary skill in the art at the time of the invention. Therefore, one of ordinary skill in the art at the time of the invention would not be able to determine the scope of the claimed “examiner.” For each of the “examiner for ...” recitations, the Examiner respectfully requests that Applicant (1) identify the corresponding structure and (2) provide specific citations to the portions of the specification that link each of the structures to its respective function.

Response to Arguments

9. The objection to the specification over the typographical error of “hush” being substituted for “hash” is withdrawn in response to Applicant’s amendment.

10. Regarding the §112, 2nd paragraph rejections of claims 1 and 31 due to the recitation “examiner,” the Examiner has concluded that this recitation invokes 35 U.S.C. §112, 6th paragraph. Although the claims do not explicitly recite “means,” the presumption that §112, 6th paragraph does not apply can be rebutted “by [1] showing that the claim element recite[s] a function [2] without reciting sufficient structure for performing that function.” *Watts v. XL Systems Inc.*, 232 F.3d 877, 880 (CAFC 2000). First, it is clear that each of the claimed examiners includes a function: “[an examiner]

for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus” (claim 1) and “[an examiner] for examining usage space information of the content data, the recording medium, and the reproducing apparatus” (claim 31). Second, one of ordinary skill in the art at the time of the invention would not understand “examiner” to denote sufficient structure for performing that function. Although the term “examiner” may denote structure in other fields, in the computer arts “examiner” is “simply a nonce word or a verbal construct that is not recognized as the name of structure and is simply a substitute for the term ‘means for.’” *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (CAFC 2004). As evidence that “examiner” does not denote structure, the Examiner notes that no entry for the word “examiner” can be found in any of the following dictionaries: the *IEEE Standard Computer Dictionary*¹ and the *Newnes Dictionary of Electronics*.² Additionally, the Examiner notes that the term “examiner” was substituted for “examining means” in the amendment filed February 19, 2009. Further, in the response filed September 15, 2009, Applicant argues that the specification element “examining means” provides implicit support for the claim element “examiner.” Remarks, pgs. 13-14. Finally, the Examiner has consulted the instant specification and is unable to locate any usage of “examiner” consistent with this element denoting structure. Therefore, the Examiner concludes that “examiner” does not denote structure and is merely a way of describing any device or programming that

¹ IEEE Standard Computer Dictionary. New York, The Institute of Electrical and Electronics Engineers, 1990.

performs the recited function. As such, "examiner" is equivalent to "means," and is "construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof" in accordance with 35 U.S.C. §112, 6th paragraph.

11. Applicant's arguments filed June 8, 2010 regarding the §112, 2nd paragraph rejection have been fully considered, but they are not persuasive. Applicant contends that the claims do not invoke §112, 6th paragraph.

12. Applicant argues that "it is not necessary that a claim term be described in a technical dictionary, for that claim term to have meaning to a person of ordinary skill in the art." The Examiner agrees. This alone was not determinative that the word "examiner" did not denote structure. It was but one factor in determining that "examiner" was merely a nonce word standing in for the word "means."

13. Applicant then argues that a person having ordinary skill would interpret "examiner" as the structure or combination of structures in the specification that perform the functions associated with the claimed "examiner." This latter argument is also consistent with interpreting the claims as invoking 35 U.S.C. §112, 6th paragraph.

14. For the above reasons, the §112, 2nd paragraph rejection of the claims is maintained.

² Newnes Dictionary of Electronics, 4th Ed. Oxford, Elsevier Science & Technology, 1999.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

16. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. K./
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621